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09/629,492	07/31/2000	Juei Chang	P3925	4269

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EXAMINER

CAMPBELL, JOSHUA D

ART UNIT PAPER NUMBER

2178

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/629,492

Applicant(s)

CHANG ET AL.

Examiner

Joshua D. Campbell

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9-11 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9-11 and 13-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to communications: Amendment filed 06/08/2005.
2. Claims 1-2, 4-7, 9-11, and 13-20 are pending in this case. Claims 1 and 10 are independent claims. Claims 1 and 10 have been amended.
3. The rejection of claims 1, 2, 4-7, and 9 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter has been withdrawn due to the amendment. The amendment reads "A software-bundle residing on a server..." which inherently shows that the software-bundle is tangibly embodied within the memory of the server apparatus.

### ***Claim Rejections - 35 USC § 112***

4. Claims 1, 2, 4-7, and 9 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As stated in the final limitation of claim 1, "...wherein the software-bundle functions as a fully automated navigation system capable of performing all of the functions of a manual navigation system controlled by a user having a data-input system for controlling the navigation system and the set of machine-readable instructions provided from an external source other than the control application," the invention must be capable of performing "all" of the functions of a manual navigation

system. However, the specification does not clearly state what all of the functions of a manual navigation system are, nor does it state how the invention supports each and every function of a manual navigation system. Thus, rendering this claim indefinite due to the lack of enablement. In order to further prosecution, the claim will be interpreted as automating the functionality of a navigation system in such a way that allows the system to perform normal actions automatically. **Proper Correction is Required.**

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-2, 4-7, 9-11, and 13-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Burson et al. (US Patent Number 6,405,245, filed on October 28, 1998).

**Regarding independent claim 1,** Burson et al. discloses a method which includes the use of a browser application to navigate on a network (Internet) (column 4, lines 36-65 of Burson et al.). Burson et al. discloses a method in which processing components (functions) of a PI engine are used to perform tasks (column 4, line 66-column 5, line 21 of Burson et al.). Burson et al. discloses a method in which the processing components are integrated into browser functionality (column 4, lines 36-65 of Burson et al.). The PI that is obtained using the PI engine contains additional instructions on how to execute transactions (column 4, line 66-column 5, line 21 of

Burson et al.). Burson et al. discloses a method in which a PI (personal information) engine (control application) will perform browser transactions invisible to the user (column 7, lines 30-67). The PI engine generates a simulated web client (browser instance) to perform tasks which are monitored, and when the task is completed the data is returned to the user interface of the browser application at which point the simulated web client is terminated and control is returned to the user interface (column 7, lines 30-67 of Burson et al.). Burson et al. also discloses a method in which additional procedures necessary to complete a transaction may be contained within the PI store (column 4, line 66-column 5, line 21 of Burson et al.). Burson et al. does not disclose the use of an API for integration purposes. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an API to allow an application such as a browser to operate in conjunction with separate processing components (i.e. Java applets – column 8, lines 13-45 of Burson et al.) because APIs are commonly used to provide communication between applets in Java virtual machine.

**Regarding dependent claim 2,** Burson et al. discloses a method which includes the use of a browser application to navigate on the Internet (column 4, lines 36-65 of Burson et al.).

**Regarding dependent claim 4,** Burson et al. discloses a method in which the PI engine (control application) is made of processing components (programs) to execute tasks (column 6, lines 24-65 of Burson et al.). It is inherent that a program operated by a computer is in the form of machine-readable instructions.

**Regarding dependent claims 5 and 6,** Burson et al. discloses a method in which a user can specify what navigation sequences to perform (one or more) (column 4, line 66-column 5, line 21 of Burson et al.)

**Regarding dependent claims 7 and 9,** Burson et al. discloses a method in which the PI engine can execute on a single processor and multiple processors (column 6, lines 24-65 of Burson et al.).

**Regarding independent claim 10,** Burson et al. discloses a method in which a PI (personal information) engine (control application) will perform browser transactions invisible to the user (column 7, lines 30-67). The PI engine generates a simulated web client (browser instance) to perform tasks which are monitored, and when the task is completed the data is returned to the user interface of the browser application at which point the simulated web client is terminated and control is returned to the user interface (column 7, lines 30-67 of Burson et al.). Burson et al. discloses a method in which the PI engine (control application) is made of processing components (programs) to execute tasks (column 6, lines 24-65 of Burson et al.). Burson et al. does not disclose the use machine-readable instructions to operate the control application. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made that a program, such as a control application (PI engine), operated by a computer would be in the form of machine-readable instructions.

**Regarding dependent claim 11,** Burson et al. discloses a method, which includes the use of a browser application to navigate on the Internet (column 4, lines 36-65 of Burson et al.).

**Regarding dependent claims 13-16**, Burson et al. discloses a method in which a PI (personal information) engine (control application) will perform browser transactions invisible to the user (column 7, lines 30-67). The PI engine generates a simulated web client (browser instance) to perform tasks which are monitored, and when the task is completed the data is returned to the user interface of the browser application at which point the simulated web client is terminated and control is returned to the user interface (column 7, lines 30-67 of Burson et al.).

**Regarding dependent claims 17 and 18**, Burson et al. discloses that automated browser functions include emulating all user input actions during navigation (column 10, lines 4-43 of Burson et al.) Burson et al. does not disclose the use of an API for integration purposes with the different functions. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an API to allow an application such as a browser to operate in conjunction with separate functions (i.e. Java applets – column 8, lines 13-45 of Burson et al.) because APIs are commonly used to provide communication between applets in Java virtual machine.

**Regarding dependent claim 19**, Burson et al. discloses a method in which the functional programs intercept the dialog necessary to navigate (i.e. cookie information) (column 8, lines 4-65 of Burson et al.).

7. Claim 20 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Burson et al. (US Patent Number 6,405,245, filed on October 28, 1998) as applied to

claim 18 above, and further in view of Thompson et al. (US Patent Number 6,571,253, filed on April 28, 2000).

**Regarding dependent claim 20**, Burson et al. does not disclose displaying the data structure in a tree format as part of the search function. However, Thompson et al. discloses a method in which in order to perform a search an HTML document is first broken down into a DOM tree which defines the hierarchal structure of the display of the document (column 2, lines 1-65 of Thompson et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of searching of Thompson et al. with the application of searching of Burson et al. because it would have increased the expressive power for locating the data item of interest.

### ***Response to Arguments***

8. Applicant's arguments filed 6/8/2005 have been fully considered but they are not persuasive.

Regarding the arguments on pages 6-7, in reference to the 112 rejection regarding claims 1, 2, 4-7, and 9, the examiner maintains the 112 rejection and believes the rejection to be proper and warranted. The enablement requirement states that a claim is not enabled if the claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim states that the invention must be capable of performing "all" of the functions of a manual



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navigation system. However, the specification does not clearly state what all of the functions of a manual navigation system are, this being important because two different people of ordinary skill in the art at the time the invention was made might have a very different interpretation of what "all" of the functionality of a manual navigation system is. In addition to this, the specification does not state how the invention supports each and every function of a manual navigation system, and one of ordinary skill in the art cannot be expected to create the invention to interact with every possible function of a manual navigation system without performing undue experimentation, without teaching these interactions in the specification. Additionally, the interpretation of "all of the functions" of a manual navigation system will undoubtedly change as manual navigation system technology advances, the applicants will not be granted inventive immunity for these functions, thus it is imperative that the specific functions and how the functions are interacted with must be disclosed in the specification in order to enable the claimed invention. Thus, claims 1, 2, 4-7, and 9 continue to suffer from lack of enablement for the above reasons and the rejection of the claims under 35 U.S.C. 112, first paragraph will be maintained as it continues to be warranted and proper.

Regarding the arguments on pages 6-9, in reference to the rejection of claims 1 specifically regarding the phrase "performing all of the functions of a manual navigation system..." the examiner believes that based on the interpretation of the claim as warranted by the lack of enablement Burson does in fact teach the claim, thus the rejection is maintained.

Regarding the arguments on pages 7-8, in reference to claims 1, 2, 4-7, 9-11, and 13-19, specifically the shortcomings of Burson based on a failed registration, the examiner feels that Burson teaches the claimed limitations as they are enabled. The examiner agrees with the applicant that the auto-registration process of the applicant's invention may be completed under partial user direction or it can be accomplished completely without user involvement. The examiner also agrees with the applicant that as sometimes necessary the end user must correct a registration attempt if the automatic attempt fails, which by definition means the registration is completed under "partial user direction". It is noted that the features upon which applicant relies (i.e., no chance of failed registration) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The examiner fails to see how the limitations presented in the claims differ from that which is presented in teachings of Burson.

Regarding the arguments on pages 9, in reference to claims 1, 2, 4-7, 9-11, and 13-19, specifically the idea that Burson teaches away from the use of APIs as disclosed, the examiner feels that Burson teaches the claimed limitations. Burson discloses that four primary processing components may operate on three different data stores which contain, the stores containing additional procedures for completing transactions (column 4, line 66-column 6, line 65 of Burson). Burson states that one of the PI stores that is associated with each user may be stored on the client computer (external to the control application) (column 5, lines 29-44 of Burson). The examiner agrees that APIs are not

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explicitly disclosed, however Burson uses Java Applets (i.e. Java applets – column 8, lines 13-45 of Burson et al.) and as the examiner stated in the rejection, APIs are an obvious an integral part of interaction between programming components and a java virtual machine as is shown by an definition/explanation of the Java Platform (The Java Platform, pages 1-2). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used APIs to operate the external components because it would have been necessary for the java virtual machine of Burson to properly function in conjunction with the other external components (applications).

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D. Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDC  
July 21, 2005

*William L. Bashore*  
**WILLIAM BASHORE**  
**PRIMARY EXAMINER**  
*7/22/2005*